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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 10/611,355 | 06/30/2003 | Kiyoshi Miyazaki | 50631/DBP/A400 | 8170 |

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| EXAMINER |
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BELL, KENT L

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| ART UNIT | PAPER NUMBER |
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1661

DATE MAILED: 11/30/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|------------------------------|-------------------------------|-----------------------------------|--|
| Office Action Summary | Application No. 10/611,355 | Applicant(s) MIYAZAKI, KIYOSHI | |
| | Examiner Kent L. Bell | Art Unit 1661 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- application filed 6/30/03*
- 1) ☒ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 6/24/03 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date <u>10/6/03</u> | 6) <input type="checkbox"/> Other: ____. |

K.L. Bell

Detailed Action

Objection to the Drawing

The submitted photographic illustrations filed February 14, 2003 have been objected to under 35 CFR 1.165(a). By way of explanation, the photographic illustrations should not be mounted (37 CFR 1.84(e)).

The rules for submitting drawings, 37 CFR 1.84 and 37 CFR 1.165, were amended effective November 29, 2000. The USPTO delayed enforcement of these changes until October 1, 2001. Complete details can be found in the May 22, 2001 *Official Gazette* (1246 OG 106-107) or on the Internet at:

<http://www.uspto.gov/web/offices/com/sol/og/2001/week21/patwavr.htm>.

Objection to the Disclosure

37 CFR 1.163

The following is a quotation of section (a) of 37 CFR 1.163:

(a) The specification must contain as full and complete a disclosure as possible of the plant and the characteristics thereof that distinguish the same over related known varieties, and its antecedents, and must particularly point out where and in what manner the variety of plant has been asexually reproduced. In the case of a newly found plant, the specification must particularly point out the location and character of the area where the plant was discovered.

35 USC 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

Detailed Action

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

As specific to United States Plant Patent applications, the specifics of 37 CFR 1.164 (reproduced below) are controlling:

The claim shall be in formal terms to the new and distinct variety of the specified plant as described and illustrated, and may also recite the principal distinguishing characteristics. More than one claim is not permitted.

In plant applications filed under 35 U.S.C 161, the requirements of 35 U.S.C. 112 are limited. The following is a quotation of 35 U.S.C. 162:

No plant patent shall be declared invalid for noncompliance with section 112 of this title if

the description is as complete as is reasonably possible. The claim in the specification shall

be in formal terms to the plant shown and described.

The disclosure is objected to under 35 CFR 1.163(a) and under 35 U.S.C. 112, first paragraph, because the specification presents less than a full, clear, and complete botanical description of the plant and the characteristics which define same per se and which distinguish the plant from related known cultivars and antecedents.

More Specifically:

Detailed Action

A. Page 1, line 9, page 14, lines 28 and 37, page 17, line 19, The Claim, and Abstract, Applicant should delete “genus” as the recitation without this term is more than adequate.

B. Page 1, line 14, Applicant states “ ‘Cineraria’ ”. It appears Cineraria is another species designation for the instant plant. If such is accurate then applicant should delete the single quotation marks as single quotation marks typically denotes a cultivar name. Correction and/or clarification is necessary.

C. Page 1, lines 24, and 37, Rather than stating “flower”, it appears --inflorescence-- would be the more appropriate term to use in these instances.

D. Page 1, line 27, Rather than stating “petals”, it appears --ray florets-- would be the more appropriate term to use in this instance.

E. Page 1, line 27, Rather than stating “flowers”, it appears --florets-- would be the more appropriate term to use in this instance.

Detailed Action

F. Page 1, lines 30 and 32, page 2, lines 2, 7, 23 and 24, page 7, line 14, and page 13, lines 31 and 36, Applicant states "*heritieri*". Applicant should review the species designation as it appears applicant may have intended to state --*heritierii*--. Correction and/or clarification is necessary.

G. Page 1, line 30, Applicant should set forth in the specification the breeding line number or name of the parental line and if unnamed, state --an unnamed plant--. Correction and/or clarification is necessary.

H. Page 2, line 15, Applicant states "No.PLANT12162, at 23.Oct.2001". It appears the recitation --U.S. Plant Patent number 12,162 on October 23, 2001-- would be more appropriate in this instance, if accurate.

I. Page 2, lines 17-20, Applicant should set forth in the specification the type of asexual reproduction used to reproduce the instant plant and the location where the asexual reproduction took place.

Detailed Action

J. Page 2, lines 6 and 7, Applicant states “crossing with *Senecio cruentus* ‘8S-84e’ and *Senecio heritieri*”. It appears that --crossing with a plant of *Senecio cruentus* ‘8S-84e’ and a plant of *Senecio heritieri*-- would be more appropriate in this instance.

K. Page 2, lines 19 and 20, Applicant states the instant plant “is uniform and stable in its characteristics”. However, this recitation does not mean the instant plant reproduces true to type in successive generations of asexual reproduction. Applicant should state in the specification --The instant plant reproduces true to type in successive generations of asexual reproduction.--, if accurate.

L. Page 2, line 25, “the” should be deleted.

M. Page 12, line 9, “everu” should be deleted and --every-- should be inserted in its place.

N. Page 12, line 11, Rather than stating “few pubescences” it appears --light pubescence-- would be more appropriate in this instance.

Detailed Action

O. Page 12, lines 20, 22, 23, 24, 26, 29, and 34, and page 13, lines 6, 10, 11, and 13, Applicant states either “flower” or “flowers”. It appears --inflorescence-- or --inflorescences--, respectively, would be the more appropriate term to use in these instances.

P. Page 12, line 25, Applicant states “petals” and “flowers”. It appears --florets-- would be the more appropriate terms to use in these instances.

Q. Page 12, line 28, Applicant states “petals”. It appears --ray florets-- would be the more appropriate term to use in this instance.

R. Page 12, line 30, Applicant states “disk flower”. It appears --entire disk-- would be the more appropriate terms to use in this instance.

S. Page 12, line 30, Applicant states “petals is”. It appears --ray florets are-- would be the more appropriate terms to use in this instance.

T. Page 12, line 31, and page 19, line 17, Applicant states “petal”. It appears --ray floret-- would be the more appropriate terms to use in this instance.

Detailed Action

U. Page 12, line 32, Applicant states “disk is”. It appears --disk florets are-- would be the more appropriate terms to use in this instance.

V. Page 12, lines 34 and 35, Applicant states “flowers” and “flower”, respectively. It appears --florets-- and --floret--, respectively, would be the more appropriate terms to use in these instances.

W. Page 12, line 37 to page 13, line 1, Applicant states “155 flowers are in a flower cluster.”. This recitation is not understood as it is unclear if applicant intends “flowers” to mean -inflorescences-- and if so is it accurate for there to be 155 of them in a cluster. Correction and/or clarification is necessary.

X. Page 13, line 12, Applicant states “petals”. It appears --ray florets-- would be the more appropriate terms to use in this instance.

Y. Page 14, lines 3 and 22, Applicant states “flower”. It appears --inflorescence-- would be the more appropriate terms to use in this instance.

Detailed Action

Z. Page 14, lines 4, 6, 8, 10, and 12, Applicant states “petals”. It appears --ray florets-- would be the more appropriate terms to use in this instance.

AA. Page 14, lines 4, 6, 8, and 12, Applicant states “flowers”. It appears --florets-- would be the more appropriate terms to use in this instance.

AB. Page 14, line 10, --florets-- should be inserted after “disk”.

AC. Page 14, line 30, Applicant states “flowers”. It appears --inflorescences-- would be the more appropriate terms to use in this instance.

AD. Page 14, line 36, Applicant states “7 months after cutting”. This recitation is not understood as it is unclear what applicant is intending. Correction and/or clarification is necessary.

AE. Page 14, line 36, Applicant should set forth in the specification the age of the plant when described.

Detailed Action

AF. Page 15, lines 9-17, Applicant should set forth in the specification additional information relative to the instant plant's stem including the typical and observed stem length and diameter.

AG. Page 15, line 17, Applicant states "Length of third internode below flag leaf". This recitation is not understood as it is unclear what applicant is intending. Correction and/or clarification is necessary.

AH. Page 15, lines 26-28, Applicant should set forth in the specification additional information relative to the instant plant's leaf including the typical and observed leaf margin descriptor.

AI. Page 15, lines 31 and 32, Applicant should set forth in the specification additional information relative to the instant plant's petiole including coloration with reference to the employed color chart.

AJ. Page 16, lines 4, 5, 6, 7, and 9, and page 19, line 15, Applicant states either "Flower" or "flower". It appears --Inflorescence-- or --inflorescence-- would be the more appropriate term to use in these instances.

Detailed Action

AK. Page 16, line 10, Rather than stating “disk flower”, it appears --entire disk-- would be the more appropriate terms to use in this instance.

AL. Page 16, lines 11, and 16-21, Applicant states “petal”, “Petal”, and “patal”. It appears --ray floret-- (either capitalized or lower case where appropriate) would be the more appropriate terms to use in this instance.

AM. Page 16, lines 11 and 12, Applicant sets forth a coloration for the instant plant’s petals (ray florets). However, it is uncertain if applicant intends the coloration set forth to be for the upper, lower, or both ray floret surfaces. Applicant should set forth in the specification the typical and observed coloration for the both surfaces of the ray florets with reference to the employed color chart.

AN. Page 16, lines 16-21, Applicant should set forth in the specification additional information relative to the instant plant’s ray florets including the typical and observed ray floret margin and base descriptors.

AO. Page 16, lines 22 and 23, Applicant states “flower”. It appears --florets-- would be the more appropriate term to use in these instances.

Detailed Action

AP. Page 16, lines 24-26, Applicant states either “flower” or “flowers”. It appears -- Inflorescence-- or --inflorescences-- (either singular or plural where appropriate) would be the more appropriate term to use in these instances.

AQ. Page 16, lines 24 and 25, Applicant should set forth in the specification additional information relative to the instant plant’s pedicel including the typical and observed pedicel length, diameter and coloration with reference to the employed color chart.

AR. Applicant should set forth in the specification additional information relative to the instant plant’s disk florets including the typical and observed shape, length, and diameter.

AS. Page 16, lines 28-32, Applicant should set forth in the specification additional information relative to the instant plant’s phyllaries including the typical and observed number, shape, and apex and margin descriptors.

AT. Applicant should set forth in the specification information relative to the instant plant’s bud including the typical and observed shape, length, diameter, and coloration with reference to the employed color chart.

Detailed Action

AU. Applicant should set forth in the specification the time it takes to produce a flowering plant.

AV. Applicant should set forth in the specification information relative to the instant plant's gynoecium and androecium including where the gynoecium and androecium are produced.

AW. Applicant should set forth in the specification whether the instant plant produces pollen. If the instant plant produces pollen then applicant should set forth in the specification the typical and observed amount produced, such as scarce, moderate, or abundant, and its generic coloration. If no pollen is produced, applicant should simply state in the specification that no pollen is produced.

AX. Page 19, lines 13 and 14, Rather than stating "several pubescences" it appears -- moderate pubescence-- or --abundant pubescence-- (whichever is more accurate) would be more appropriate in this instance.

AY. Page 19, line 18, Applicant states "flower is". It appears --florets are-- would be the more appropriate terms to use in this instance

Detailed Action

AZ. Page 19, line 19, Applicant states "Flower". It appears --Inflorescence-- would be the more appropriate terms to use in this instance

The above listing may not be complete. Applicant should carefully review the disclosure and import into same any corrected or additional information which would aid in botanically identifying and/or distinguishing the cultivar for which United States Plant Patent protection is sought.

Claim Rejection

35 U.S.C. 112, 1st & 2nd Paragraphs

Claim 1 is rejected under 35 U.S.C. 112, first and second paragraphs as not being supported by a clear and complete botanical description of the plant for the reasons set forth in the Objection to the Disclosure Section above.

Serial Number: 10/611,355
Art Unit: 1661

Page 15

Detailed Action

Future Correspondence

Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Kent L. Bell whose telephone number is (571) 272-0973. The Examiner can normally be reached Monday through Thursday from 6:00 am to 4:30 pm.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Andrew Wang, can be reached at (571) 272-0811.

The fax phone number for the group is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (571) 272-1600.

K. L. Bell

**KENT BELL
PRIMARY EXAMINER**

A handwritten signature in cursive script that reads "Kent L. Bell". The signature is written in dark ink and is positioned below the printed name and title.